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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,087	05/29/2002	Stefan Disch	1999/G-017	9098

7590

07/17/2006

Conolly & Hutz
P O Box 2207
Wilmington, DE 19899

EXAMINER

NUTTER, NATHAN M

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/069,087

Applicant(s)

DISCH ET AL.

Examiner

Nathan M. Nutter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 11, 12, 14-19 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 11, 12, 14-19 and 21-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

In response to the amendment filed 30 May 2006, the following is placed in effect.

The rejection of claims 1-3, 11, 12 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, is hereby expressly withdrawn.

The provisional rejection of claims 1-3, 11, 12 and 14-26 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/381,501, is hereby expressly withdrawn.

The provisional rejection of claims 1-3, 11, 12 and 14-26 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31 of copending Application No. 10/663,290, is hereby expressly withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 11, 12 and 14-19 and 21-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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The recitations in the claims of "determined on test specimens in accordance with the German Automotive Industry Recommendation No. 275 (VDA 275)" has no bearing in the determination of patentability of the claims. This "Recommendation" is not cited as a test performed with regularity or one employed in this country. As such, the recitation renders the claims as vague and confusing.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 11, 12 and 14-19 and 21-26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31 of copending Application No. 10/381,502. Although the conflicting claims are not

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identical, they are not patentably distinct from each other because although the specific level of formaldehyde emission is not disclosed, the reference discloses "low formaldehyde emission" as a feature of the composition in the Abstract. The application discloses the use of pigments at paragraph [0027] and throughout the Specification. At paragraph [0036] the reference teaches the identical polyoxymethylene copolymers as herein contemplated.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-3, 11, 12 and 14-19 and 21-26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,306,940 (Disch et al). Although the conflicting claims are not identical, they are not patentably distinct from each other because although the specific level of formaldehyde emission is not disclosed, the reference discloses "very low formaldehyde emissions" as a feature of the composition in the Abstract. The application discloses the use of pigments at and the identical polyoxymethylene copolymers as herein contemplated at column 2 (lines 24-56).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 11, 12, 14-19 and 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Auerbach et al (US 4,666,995) taken with Paul et al (US 4,727,106) in view of Chapman et al (US 3,656,982), all in view of Mück et al (US 5,994,455).

The references to Auerbach et al (US 4,666,995), Paul et al (US 4,727,106), Chapman et al (US 3,656,982) and Mück et al (US 5,994,455) teach the manufacture of compositions comprising polyacetal copolymers having oxymethylene and oxyethylene units.

The reference to Auerbach et al (US 4,666,995) teaches the production of the oxymethylene copolymer using a strong protonic acid initiator at column 3 (lines 33-39). The reference shows the employment of pigments at the paragraph bridging column 8 to column 9, which also shows the use of stabilizers and other additives. The ratio of oxymethylene to oxyethylene groups is taught at column 4 (lines 9-13) to be "from about 6 to 1 to about 1000 to 1," which is clearly within the range recited in claims 11 and 22.

The reference to Paul et al (US 4,727,106) also shows the use of strong protonic acid initiators at column 4 (lines 23-29). Paul et al teaches the use of pigments, including black and white, and other additives, including stabilizers, at column 11 (lines 3-21) "in amounts of up to about 5% by weight," as recited in instant claims 2, 15 and 16. The reference shows the reduced formaldehyde emissions at Table 1, columns 11 and 12.

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The reference to Chapman et al (US 3,656,982) shows the conventionality of the employment of a colorant that has a "coating of an alkali metal salt of a fatty acid having at least 12 carbon atoms" as recited in claims 3 and 17 in polyoxymethylene copolymer compositions, as recited and claimed herein. Note column 2 (lines 18-35) and the many Examples.

The patent to Mück et al (US 5,994,455) is relied upon solely to show the use of the trifluoromethanesulfonic acid initiator, as recited in claim 15. Note column 1 (lines 21-39) and Example 1 at the paragraph bridging column 3 to column 4.

All of the references are drawn to polyoxymethylene copolymers. The references to Auerbach et al (US 4,666,995), Paul et al (US 4,727,106) and Mück et al (US 5,994,455) all show the use of a protonic acid as the initiator, with Mück et al showing the specific initiator of claim 15. Employment of this initiator in the production of the oxymethylene copolymers of either Auerbach et al or Paul et al would be prima facie obvious since all disclose the class of initiators, as claimed. The particular employment of the pigments and other additives, including the stabilizer, in amounts as herein claimed is shown by the teachings of Paul et al. The skilled artisan, likewise, would know the suitable amounts of each to use for desired effect. The employment of the particular colorant as recited in claims 3 and 17 in a polyoxymethylene composition is shown to be conventional by Chapman et al (US 3,656,982). Since the copolymers are produced in the same manner as disclosed herein, and may employ the same protonic acid initiators, the emission of formaldehyde would be inherent. All parameters of the claims are deemed to be shown by the references to be conventional. As such, the

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instant claims would have been obvious, in the sense of 35 USC 103(a) in view of the teachings of the references.

Response to Arguments

Applicant's arguments filed 30 May 2006 have been fully considered but they are not persuasive.

With regard to the rejection of claims 1-3, 11, 12 and 14-19 and 21-26 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, it is pointed out that, while applicants contend the usefulness and the universality of the Verband der Automobilindustrie (VDA) test, the recitations in the claims as drawn thereto are deemed to be vague and confusing for the same reasons that a trademark recitation may be vague, or that reference to a drawing in a claim might be vague. The information extrapolated therefrom is from a European standard and not to a standard widely employed in the United States. While applicants show references citing such standard as used, the standard has not been shown to be universally accepted such as measurement of melt flow rate. Regardless, since the standard is European there is no guarantee that the standard will remain forever unchanged for US compositions and may be changed at the whim of the German automotive industry. As such, the recitation renders the claims as vague and confusing.

With regard to the provisional rejection of claims 1-3, 11, 12 and 14-19 and 21-26 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31 of copending Application No. 10/381,502, applicants attempt to

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portray the reference as requiring additional constituents, not recited in the instant claims, that would pose some effect on the formaldehyde emissions. It is pointed out that applicants claims recite "comprising" which does not exclude other constituents, even in major amounts. Both the reference and the instant claims recite low formaldehyde emissions. Applicants have asserted a difference without showing why that difference, i.e. emissions, would differ.

With regard to the rejection of claims 1-3, 11, 12 and 14-19 and 21-26 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,306,940 (Disch et al), it is pointed out to applicants that the reference may be used as a molding composition, per se, without the addition of other resin(s). Applicants' contention that the term "concentrate" would produce any difference in scope of claim is irrelevant and clearly without merit.

With regard to the rejection of claims 1-3, 11, 12 and 14-19 and 21-26 under 35 U.S.C. 103(a) as being unpatentable over Auerbach et al (US 4,666,995) taken with Paul et al (US 4,727,106) in view of Chapman et al (US 3,656,982), all in view of Mück et al (US 5,994,455), applicants assert that the characteristic of reduced formaldehyde emissions as the thrust of the invention, and that the references, in their failure to recognize this characteristic, cannot negate the patentability of the instant claims. This is further predicated by applicants with reference to the constituents disclosed by the references. Concerning the reference to Auerbach et al, it is applicants' contention that the mere recitation of possible constituents provides "no motivation to particular (sic) select any of the optional ingredients." The disclosure that these constituents are

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optional would present itself to a skilled artisan as motivation enough to select some, many, any or all of those optional components, and the recitations of the instant claims do not exclude such. The same is true concerning the disclosure of Paul et al. The disclosure of Paul et al that these constituents are optional would present itself to a skilled artisan as motivation enough to select some, many, any or all of those optional components, and the recitations of the instant claims do not exclude such. Applicants have argued the merits of the rejection as though the claims were rejected under 35 USC 102, which they were not. The reasons and motivation to combine the references are discussed in the rejection above. Again, applicants attempt to assert patentability of the claims with reference to the characteristic of low formaldehyde emissions. This characteristic is recited as an inherency to the composition, as recited, yet applicants have failed to show any manipulation of either composition or constitutional limitations that are without the purview of the references cited that would provide the desired characteristic, and none have been recited and claimed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

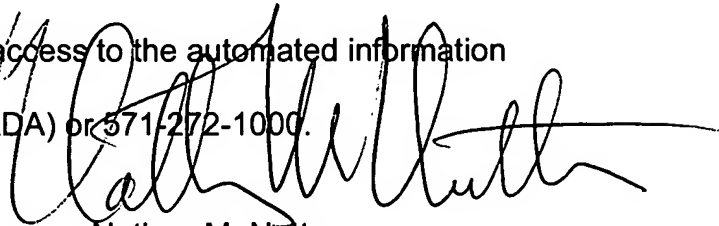
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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Nathan M. Nutter
Primary Examiner
Art Unit 1711

nmn

10 July 2006